

P15733.A02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : W. DOVIAK et al.
Serial No : 08/932,532
Filed : September 17, 1997
For : APPARATUS AND METHOD FOR INTELLIGENT ROUTING OF DATA
BETWEEN A REMOTE DEVICE AND A HOST SYSTEM

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Examiner: Sean

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U.S. PAT. & TRADEMARK OFFICE

INFORMATION DISCLOSURE STATEMENT

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In accordance with the duty of disclosure under 37 C.F.R. 1.56, 1.97-1.98, Applicants hereby call the following documents to the Examiner's attention:

The following documents are discussed on pages 2-7 of the specification:

U.S. Patent No. 5,412,375, to WOOD, issued on

U.S. Patent No. 5,420,574, to ERICKSON et al., issued on

U.S. Patent No. 5,452,471, to LEOPOLD et al., issued on

U.S. Patent No. 5,537,220, to EZUMI et al., issued on

U.S. Patent No. 5,602,843, to GRAY, issued on

Applicants also bring to the Examiner's attention the following co-pending parent application:

U.S. Application Serial Number 08/456,860, which has been allowed but has not yet issued as a U.S. Patent.

In accordance with 37 C.F.R. 1.98(a) (iii), a copy of the above-mentioned application is not attached hereto. The Examiner is requested to review the file wrapper of this U.S. patent application.

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at the U.S. Patent and Trademark Office. Of course, if for any reason the Examiner cannot locate the application, Applicants will provide any requested materials, if possible.

The following U.S. Patents and publications were cited in the Information Disclosure Statement filed September 1, 1995 in parent Application No. 08/456,860:

U.S. Patent No. 5,249,218, to SAINTON, issued on September 28, 1993;

U.S. Patent No. 5,353,334, to O'SULLIVAN, issued on October 4, 1994;

U.S. Patent No. 5,367,563, to SAINTON, issued on November 22, 1994;

U.S. Patent No. 5,127,041, to O'SULLIVAN, issued on June 30, 1992;

U.S. Patent No. 4,972,457, to O'SULLIVAN, issued on November 20, 1990; and

U.S. Patent No. 4,697,281, to O'SULLIVAN, issued on September 29, 1987.

"KeyWare™ - A Wireless Distributed Computing Environment," Racotek White Paper, RACOTEK, Inc., Minneapolis, MN, 1995;

"MAVRIC 2000: Integrated Data and Voice Communications System," MAVRIC 2000 Performance Specifications Brochure, Metric Systems Corp., Acton, MA, 1991;

"RacoNet: Mobile Data Communication Services Product Catalog," Rev. 1.03, RACOTEK, Inc., Minneapolis, MN, 1993;

"Racotek: Design Considerations for Mobile Data Applications," Racotek 400-0054-00, RACOTEK, Inc., Minneapolis, MN, January 1993;

"RacoNet: Mobile Data Communications Services Price List," Rev. 1.03, RACOTEK, Inc., Minneapolis, MN, 1993;

"MPS II System Component: Mobile System Printer," Racotek Sales Brochure, RACOTEK, Inc., Minneapolis, MN, February 1990;

"MPS II System Component: Mobile System Data Terminal," Racotek Sales Brochure, RACOTEK, Inc., Minneapolis, MN, February 1990;

"MPS II System Component: Adaptive Network Modem," Racotek Sales Brochure, RACOTEK, Inc., Minneapolis, MN, February 1990;

"Racotek Overview," RACOTEK, Inc., Minneapolis, MN, 1993;

"Unify Your Mobile Data Communications with RacNet," Racotek Sales Brochure, RACOTEK, Inc., Minneapolis, MN, 1992;

"The Race is Won by the Fleet," Racotek Sales Brochure, RACOTEK, Inc., Minneapolis, MN (publication date unknown);

Datalines, Volume 5, No. 2, RACOTEK, Inc., Minneapolis, MN, April 1993;

Datalines, Volume 5, No. 3, RACOTEK, Inc., Minneapolis, MN, September 1993;

Datalines, Volume 6, No. 1, RACOTEK, Inc., Minneapolis, MN, February 1994;

"RACOTEK/HDC: Operations Booklet for Mobile Data Terminals," RACOTEK, Inc., Minneapolis, MN, 1993;

I. SHPANCER et al., "Open Data-On-Voice Systems for SMRs," RACOTEK - Radio Computer Technologies, presented at NABER's 1990 Annual Meeting, May 9-12, Tampa, FL, 1990;

"How to Hold Together a Business that Heads Off in Every Direction," RaCoNet Networking Software," Racotek Sales Brochure, RACOTEK, Inc., Minneapolis, MN (publication date unknown);

Robert J. FRASER, "The MTS-Part II," Communications, pp. 52-55, August 1991;

"Wireless Data Communications and RAM Mobile Data," RAM Mobile Data Sales Brochure, RAM Mobile Data U.S.A., 1992;

"RAM Mobile Data: Field Service," RAM Mobile Data Sales Brochure, RAM Mobile Data U.S.A., 1992;

"Market Opportunities for System Integrators, Mobile Data Terminal Manufacturers, Radio and Modem Manufacturers, and Software Developers," RAM Mobile Data Sales Brochure, RAM Mobile Data U.S.A. (publication date unknown);

On the Air, a quarterly publication of ARDIS, Lincolnshire, IL, Vol. 3, Spring 1993;

On the Air, a quarterly publication of ARDIS, Lincolnshire, IL, Vol. 4, July 1993;

On the Air, a quarterly publication of ARDIS, Lincolnshire, IL, Vol. 5, Fall 1993;

Robert B. EULER, "Making the Mobile Communications Connection," MSM Magazine, June 1990;

"ARDIS Marks First Birthday of Network Operation," ARDIS News Release, ARDIS, Lincolnshire, IL, April 1991;

"ARDIS Extends its Reach into Canada," ARDIS News Release, ARDIS, Lincolnshire, IL, February 1992;

"ARDIS Focuses on Sales Force Automation," ARDIS News Release, ARDIS, Lincolnshire, IL, October 1993;

"ARDIS Sets the Standard for Wireless Data Communications," ARDIS News Release, ARDIS, Lincolnshire, IL (publication date unknown);

"How Does One Overnight Delivery Service Guarantee Overnight Success?," ARDIS Sales Advertisement, ARDIS, Lincolnshire, IL (publication date unknown);

"ServiceXpress," ARDIS Sales Brochure, ARDIS, Lincolnshire, IL (publication date unknown);

"ARDIS is the First Radio Frequency Network for the Motorola Envoy Wireless Personal Communicator," Communications by Ardis, ARDIS Sales Brochure, ARDIS, Lincolnshire, IL (publication date unknown);

"ARDIS," Company Profile Brochure, ARDIS, Lincolnshire, IL (publication date unknown);

"ARDISmailSM 100: The Wireless E-Mail Package," ARDIS Sales Brochure, ARDIS, Lincolnshire, IL (publication date unknown);

"Congratulations. You Have the Sale!," ARDIS Sales Brochure, ARDIS, Lincolnshire, IL (publication date unknown);

"Wireless Solutions can Mean the Difference...", ARDIS Sales Brochure, ARDIS, Lincolnshire, IL (publication date unknown);

"Achieving the Highest Level of Productivity with New Thinking and a New Vision," ARDIS Sales Brochure, ARDIS, Lincolnshire, IL (publication date unknown);

Form S-1 Registration Statement of RACOTEK Inc. (with exhibits), as filed with the Securities and Exchange Commission on October 22, 1993; and

Amendment No. 1 to Form S-1 Registration Statement of RACOTEK Inc., as filed with the Securities and Exchange Commission on November 4, 1993.

Lastly, in the parent application Applicants brought testing and experimental activity prior to the filing of the parent application to the Examiner's attention:

Prior to the filing of the parent application, the Assignee (PADCOM, Inc.) participated in test pilot programs to experiment and develop the hardware and software of the invention to which this application is directed. Test pilot programs are standard in the industry and occur later in development process as part of an overall research and development plan for a new product. The test pilot programs are for the purposes of testing and debugging the hardware and software in a "real world environment," rather than in a controlled laboratory. For the reasons stated below, the test pilot programs relate to experimental activity and do not give rise to a statutory bar under Section 102(b).

The first test pilot program involved an earlier embodiment of the invention which failed to perform adequately for its intended purpose. Throughout the first test pilot program, control and access to the deployed system was restricted and tightly maintained. Further, upon completion of the first test pilot program, all equipment was returned to PADCOM. Following completion of the first test pilot program, PADCOM performed additional testing and development at their own facilities and participated in a second test pilot program to perform additional testing on the system. The second test pilot program began less than one year prior to filing of the parent application.

In order to facilitate the Examiner's consideration of the test programs, Applicants have provided below a brief outline of the events related to the first test pilot program. Applicants are aware of certain other materials related to the first test pilot program which they would like to submit for the Examiner's consideration during prosecution of the above-captioned application. However, permission was never granted by the source(s) of the document to submit the documents to the PTO because these materials are considered proprietary and confidential by the source(s) of such material. Nonetheless, the documents have been reviewed, and it is noted for the record that they do not disclose a system similar to the system claimed in the present application.

The first test pilot program was based on a requirement to develop and deploy a voice radio and data-over-radio system. A general proposal to meet the requirements was submitted on October 26, 1993. The proposal included plans to develop an operational system to meet the specified requirements. A more specific test criteria and plan were drafted on November 22, 1993. On December 28, 1993, a Purchase Order was sent for the installation of the test pilot system. The Purchase Order was to cover the support services, travel expenses, field service and equipment used during the 90 day test pilot period.

On January 5, 1994, the system hardware and software to be used in the test pilot program was installed in two vehicles for initial testing. Access to the test equipment in the vehicles was tightly controlled, and experimentation and use of the system was limited to only one person. As of February 22, 1994, the system was not sufficiently stable to begin the test pilot program, and an action plan was developed to identify and resolve the outstanding issues. From May 23, 1994 through May 26, 1994, employees of PADCOM attempted to solve several reproducible errors with both the hardware and software contained in the experimental system. Several features of the system had to be disabled in order to make the system operational. When this system was tested, unsatisfactory performance was realized when several mobile data controllers were attempting to

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access the host system. As a result, further features of the system were disabled in order to streamline the processing.

Once the test pilot program began on June 2, 1994, further modifications to both the hardware and software were necessary to realize an operational system. The hardware and software were again modified to support communication between the mobile system and an IBM 3270 host network on October 7, 1994. After the test pilot program ended on November 21, 1994, all of the equipment was returned to PADCOM due to unsatisfactory performance and the need for further development of the system.

The following materials were cited in the Supplemental Information Disclosure Statement filed May 14, 1997 in parent Application No. 08/456,860:

Ericsson GE, "Mobile Data System Evolution", publication date unknown;

Ericsson GE, "Mobile Data Questions & Answers", dated March 3, 1994;

Ericsson GE, "Private Radio Systems EDACS® Data Advantage™ Technical Description", publication date unknown;

Motorola, Inc., "Integrated Voice and Data System Description", publication date unknown;

Motorola, Inc., "VRM-100 Vehicular Radio Modem", publication date unknown;

Motorola Private Systems Division Land Mobile Products Sector, "VRM 100 Vehicular Radio Modem For Integrated Voice and Data Operation on Smartnet and Smartzone Trunked Radio Systems and Conventional Radio Systems - Product Description", April 5, 1994; and

Motorola Mobile Data Division, "RPM Native Mode Interface R1.1 Reference Manual", published September, 1992.

Copies of the above-materials except for the patents listed on page 1 are in Parent Application No. 08/456,860, which complies with 37 C.F.R. 1.98(d) regarding the copies.

Applicants respectfully request that the Examiner consider and cite these documents. Copies of the above-noted documents have been listed on a PTO-1449 Form which is also attached.

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Accordingly, the Examiner is requested to initial the appropriate spaces on the attached PTO-1449 Form and to return a copy of the form to the Applicants with the next official communication in the present application to confirm consideration of these documents.

Should there be any questions, the Examiner is invited to contact the undersigned at the below-listed number.

Respectfully submitted,
W. DOVIAK et al.

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December 31, 1997
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